Supreme Court of the United States

OCTOBER TERM, 1946

No. 740

THE FOXBORO COMPANY,
Petitioner-Plaintiff,

v.

TAYLOR INSTRUMENT COMPANIES,
Respondent-Defendant.

REPLY BRIEF FOR PETITIONER

The petitioner asks leave to present this Reply Brief, limited to pointing out errors in the Brief for the Respondent.

1. The conflicting decisions among the Circuit Courts of Appeal.

The Respondent's Brief implicitly, if not expressly, admits this conflict and asserts (p. 2) that the decision in the case at bar was not rested on the asserted claimed change in the standard of invention adopted by the Supreme Court. This repudiates the statement by the Court itself of the basic reason for its decision as to Mason's invention, namely:— "So far as he is concerned, his work is merely the latest refinement of a continuous progress, proceeding by trial and error", 157 F. (2d) 233 (R. 1557). No more

significant language could be chosen to express that this decision is based on the test now applied in the Second Circuit: that nothing is invention which is preceded by a number of trials and failures. The testimony (R. 1022-1030) showed that the work of the prior patentees had not made progress toward Mason's invention but, on the contrary, away from it (R. 1577, 1578). The District Court had found in fact that the prior devices lacked the control of the difficult processes which was furnished by Mason's novel combination (Dft. R. 670, 671). The opinion of the Circuit Court of Appeals is rested squarely on its interpretation and on the superlative significance which that Court has alone attached to the "flash of genius" words of the Supreme Court. The Court of Appeals for the Second Circuit has created this latest test, that nothing is invention which is preceded by a number of trials and failures. It has used the most exact words in this opinion to show that it is applying to this case that test. That test, which does not prevail in the other Circuits, is the reason why the decision in this case in the Circuit Court of Appeals, overruling the District Court, was against the plaintiff.

2. The reversal of findings of fact of the District Court.

The Respondent's Brief (pp. 2, 3, 6, 9 and 11) fails to meet the Petitioner's Brief (pp. 14, 15). The District Court in its decision was not actuated by the mere skill of the linguist in reading the prior patents; it was dealing in the light of the testimony with the significance of those patents as applied to practical operations. The testimony disclosed failure to meet the urgent need until the combination set out in the claims was conceived and applied by Mason. The Court of Appeals in its opinion makes comparison between

individual earlier patents and some of the component parts of Mason's combination invention. It does not deal with the fact that there was no prior conception of that combination and that it was that novel combination which produced the emphatic success. The Respondent's Brief points out the very language of the opinion of the Court of Appeals which the petitioner submits was erroneous, in that it announced facts contrary to the findings of fact of the District Court. Those facts were amply supported by the evidence before the District Court, on which the Court of Appeals makes no comment. A mere cloistered interpretation of documents is not to be substituted wisely for the testimony of witnesses, seen, heard and believed, which gives significance in practical operation to the documents.

The Respondent's Brief says (p. 8) that the trial court was "apparently * * * befuddled". The petitioner asks that the trial court be not convicted of this by the Supreme Court before hearing argument and the extensive testimony cited at page 7 of the petition. On this testimony the trial court found that the devices of the three patents could not control difficult processes and did not have Mason's novel combination which gave the accurate proportioning action and reset action (R. 670, 671).

The opinion of the District Court is not to be ignored in determining the findings of fact which it made. *Hazeltine Corporation* v. *General Motors Corporation,* 131 F. (2d) 34, 37, C. C. A. 3, 1942.

The assertion of the Respondent's Brief (p. 7) that the Court made "no true finding of fact" with respect to the prior art is an assertion which asks the Court, without considering the evidence in the record, to decide that the finding of fact of the District Court was not a true finding.

This cannot be done without considering the entire evidence and emphatically that at R. 241-290, 975-997, 1022-1030. One of the causes of the error in the Circuit Court of Appeals, it is respectfully submitted, was the failure to give consideration to this evidence and to the findings of fact in the District Court so amply supported by it.

It is submitted that the Brief for the Respondent deviates from the record and does not meet at a single point the Petition and Brief for the Petitioner.

Respectfully submitted,

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December 31, 1946.